

REMARKS

Claims 1-50 are currently pending in this application. Claims 1, 2, 6, 9, 17, 26, 38, 39 and 45 have been amended while the remaining claims remain unchanged. New claims 48-50 have been added. No new subject matter is believed to have been added by this amendment.

On page 2 of the Office Action, the Examiner indicates that the Oath or Declaration is defective. Please find attached with this Office Action an executed Declaration and Power of Attorney directed to the subject application.

On page 2 of the Office Action, the Examiner objects to the format of the Abstract. The Abstract has been rewritten so that it is contained within a single paragraph.

On pages 3 and 4 of the Office Action, the Examiner presents numerous objections, objecting to claims 1-47 for reasons listed on those pages. Claims 1, 2, 6, 9, 17, 26, 39, and 45 have been amended to address these objections.

On page 5 of the Office Action the Examiner rejects claim 38 under 35 U.S.C. § 112, second paragraph as being indefinite. Claim 38 has been amended and is no longer believed to be indefinite. Additionally, elements of claim 38 have been removed and introduced into new claim 48.

On pages 5-8 of the Office Action, the Examiner rejects claims 1-8, 9-16, 17-25, 26-38, 39-44, and 45-47 under 35 U.S.C. § 101 indicating the claimed invention is directed to non-statutory subject matter. The independent claims in each of these groups, in particular claims 1, 9, 17, 26, 39, and 45 have been amended to make clear that the methods associated with these claims utilize a computer. For that reason, each of these methods now recites how each associated process affects, effects, or is effected by technology. For that reason, claims 1, 9, 17, 26, 39, and 45 are now believed to contain statutory subject matter and, by way of their dependence upon these claims, claims 2-8, 10-16, 18-25, 27-38, 40-44, 46 and 47 are also believed to contain statutory subject matter.

On page 9 of the Office Action, the Examiner rejects claims 1, 2, 3, 4 and 6 under 35 U.S.C. § 103(a) as being obvious from the teaching of the articles on the PackageNet web site as of April 20, 1999 in view of the article "MICROSOFT: The Microsoft Plaza Brings Product Returns Convenience to Online Shoppers", hereinafter, "Microsoft Plaza".

Briefly summarizing, the general concept of one embodiment of the subject invention is to induce a purchaser to visit one of a number of different retail outlets for a pre-ordered package pick up or return based upon benefits provided to the purchaser from that retail outlet. The package to be picked up or returned is from a source different than the retail outlet itself. As indicated in amended claim 1 the at least one benefit may be a reduction in shipping cost or in-store credit or discount coupons provided by the retail outlet to the purchaser, wherein the in-store credit is not credit for the return of a product. Generally speaking, this method provides, among other things, two different retail outlets an opportunity to compete to increase foot traffic within their store and thereby promote the sale of their in-store products. This method also allows retail outlets and others to market to a purchaser known to be visiting the retail outlet in the near future.

The PackageNet web site describes a service through which a customer may order a product from a supplier and the product may be shipped to the customer utilizing a single commercial carrier. PackageNet acts as an intermediary between the customer and the carrier by providing a number of different retail outlets that are available to receive and hold the customer's order until the order may be picked up at the customer's convenience. There is neither a teaching nor a suggestion in this reference of benefits found in claim 1 being provided by individual retail outlets to influence the selection by the purchaser of picking up or returning a package at one of these retail outlets. The Microsoft Plaza reference is similar in teaching to the PackageNet reference but introduces the option of returning a package in the same manner by which it was picked up at one of the many retail outlets and therefore, the same arguments applied to the PackageNet article apply here.

For these reasons, the Applicants do not believe that claim 1, as amended, is made obvious by the teaching of these references. Additionally, by way of their dependence upon what is believed to be patentably distinct independent claim 1, dependent claims 2-8 are themselves believed to be patentably distinct.

On page 12 of the Office Action, the Examiner rejects claims 39 and 40 under 35 U.S.C §103(a) as being obvious from the teaching of United States Patent No. 5,832,457 to O'Brien et al. in view of the teaching of the article "IP: NYT Digital Commerce: Is Delivery the Dealbreaker for E-Commerce?" by Galler (the Galler article). The O'Brien patent is directed to a method and apparatus for selective distribution of discount coupons based on prior customer behavior. Such discount coupons are provided immediately after

checkout and require the customer to be present in the establishment. In particular, the prior customer behavior referenced in the O'Brien patent is that behavior associated with a single establishment. As an example, a supermarket may track the purchases of a particular customer and, in subsequent visits by that customer, provide coupons directed to the particular needs or interests of that customer based on the prior customer behavior at that supermarket. Furthermore, as described in the Abstract, the O'Brien patent is directed to a system for automatically distributing discount coupons or certificates in a retail store conditioned on a pre-selected combination of present and past shopping behavior of a customer whose order is being processed at a check-out stand. The customer is already in the store and is essentially being rewarded to purchase more or to return to the store based upon data generated while the customer was present and shopping in the store. Claim 39, as amended, on the other hand, is directed to receiving information prior to the store visit wherein such information includes data independent of that collected by the store based upon prior customer behavior with that store. As a result, in accordance with claim 39, a store may directly market to an individual in advance of that individual entering the store based upon information about the individual associated with the pre-ordered product. Therefore, in return for information about the individual that will be visiting a store, that store may directly market to the individual they know will be visiting their store.

The Galler article describes again the activities of PackageNet and in particular suggests the pick up or return of a pre-ordered product not discussed in the O'Brien patent. However, nevertheless the PackageNet system as described in the Galler article merely permits a purchaser to pick up or return a product from any one of a number of different locations. There is neither a teaching nor a suggestion that marketing information may be provided to these outlets and furthermore that such information might be used to directly market to the individual associated with the product.

For these reasons, the Applicants do not believe that claim 39 is obvious in view of these cited references and, therefore, is believed to be patently distinct over the cited references. Additionally, claim 40, based upon its dependence upon what is believed to be patentably distinct independent claim 39, is itself believed to be patentably distinct.

The Examiner, on page 12 of the Office Action, rejects claim 41 under 35 U.S.C §103(a) as being obvious from the teaching of the O'Brien patent in view of the teaching of the Galler article and, further in view of the articles on the PackageNet web site.

Claim 41 defines direct marketing as the step of providing a reduction in shipping cost based upon marketing variables. By way of its dependence upon what is believed to be patentably distinct claim 39, claim 41 is itself believed to be patentably distinct.

On page 13 the Examiner rejects claim 42 under 25 U.S.C §103(a) as being obvious from the teaching of the O'Brien patent in view of the teaching of the Galler article and furthermore in view of the articles of the PackageNet web site and, finally, in view of official notice. Claim 42 depends from what is believed to be patentably distinct independent claim 39 and therefore, is itself believed to be patentably distinct.

The Examiner rejects claims 43 and 44 under 35 U.S.C §103(a) as being obvious from the teaching of the O'Brien patent and the Galler article and further in view of official notice. Once again, claims 43 and 44 depend from what is believed to be patentably distinct independent claim 39 and are therefore believed to be patentably distinct.

On pages 14 and 15 of the Office Action the Examiner rejects claims 45 and 46 under 35 U.S.C §103(a) as being obvious from the teaching of the O'Brien patent in view of the teaching of the Galler article. Claim 45 is directed to a method of direct marketing to individuals visiting a store at a remote location comprising the steps of receiving, using a computer, information about an individual prior to the store visit wherein such information includes data independent of that collected by the store based upon prior customer behavior with that store. As previously discussed, neither the O'Brien patent, nor the Galler article teaches or suggests receiving for direct marketing information about an individual prior to the visit to the store wherein such information includes data independent of that collected by the store based upon prior customer behavior with that store. For these reasons the Applicants believe claim 45 is patentably distinct over these references and furthermore, by way of its dependence upon what is believed to be patentably distinct independent claim 45, claim 46 is itself believed to be patentably distinct.

On page 15 of the Office Action, the Examiner rejects claim 47 under 35 U.S.C §103(a) as being obvious from the teaching of the O'Brien patent and the Galler article in view of the PackageNet web site. As the Examiner suggests, claim 47 is similar to claim 41 and the same argument applies thereto. Furthermore, claim 47 depends from what is believed to be patentably distinct independent claim 45 and therefore is itself, believed to be patentably distinct.

On page 15 of the Office Action, the Examiner indicates that claims 9-16 would be allowed if amended to overcome the rejection under 35 U.S.C. §101 and the minor informalities objected to. Claims 9-16 have been amended to address these issues and are now believed to be allowable.

On page 16 of the Office Action the Examiner indicates that claims 17-25 would be allowable if amended to overcome the rejections under 35 U.S.C. §101 and the minor informalities objected thereto. Claims 17-25 have been amended and are now believed to be allowable.

On page 17 of the Office Action the Examiner indicates that claims 26-38 would be allowed if amended to overcome the rejections under 35 U.S.C. §101 and the minor informalities objected to, and, with respect to claim 38, the rejection under 35 U.S.C. §112, second paragraph. Claims 26-38 have now been amended in such a fashion and are believed to be in condition for allowance.

New claim 48 has been added as a claim dependent upon claim 38 and including a portion of the text of originally filed claim 38. By way of its dependence upon what is believed to be patentably distinct independent claim 26, dependent claim 48 is itself believed to be patentably distinct.

New claims 49 and 50 have been added a dependent upon claim 1. Claim 49 includes the cancelled element of claim 1 while claim 50 specifies that the reduction in shipping may be provided by the shipper. None of these features is believed to be present in the prior art of record and therefore these claims are believed to be patentably distinct.

Included with the Office Action was a Notice of Draftperson's Patent Drawing Review objecting to the features of Figure 3. A new copy of Figure 3 is being filed herewith, modified to address these concerns.

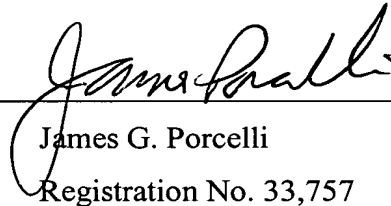
Application. No.09/707,185
Amendment dated April 19, 2004
In Reply to Office Action of November 18, 2003
Attorney Docket No. 3520-000808-H

Reconsideration of claims 1-47 and allowance of claims 1-50 are respectfully
requested.

Respectfully submitted,

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